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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/656,040
Filing Date: September 04, 2003
Appellant(s): DECKERS, STEPHEN V.

Thomas Olson
Hewlett-Packard Company
Intellectual Property Administration
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/25/2005.

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This is in response to the appeal brief filed 04/25/2005.

1. A statement identifying the real party in interest is contained in the brief.

2. The statement of related appeals an interferences is correct.

3. The statement of the status of the claims contained in the brief is correct.

4. The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

5. The summary of the claimed subject matter contained in the brief is correct.

6. The grounds of rejection to be reviewed on appeal are partly correct. Appellant's brief presents arguments relating to Drawing objection under 37 CFR 1.83(a). This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

The grounds of rejection to be reviewed on appeal is followed:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 45 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The original specification did not describe in detail how a single docking device 330 (Figure 4) could link either a tape cartridge or a hard disk drive to the host device. The

specific of how the tape read/write device 231 and the docking interface 122 are designed to co-locate on a single docking device to serve the claimed functions is not known. The mere statement that the tape read/write device can be combine with the docking interface on one docking device does not provide sufficient enablement for the claimed invention. Based on the original written description, one of ordinary skill in the art would not be able to make and/or use the claimed invention without undue experimentation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 28, 37, 38, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski et al. 6,731,455 in view of Stefansky 5,329,412.

Kulakowski '455 discloses a data storage library per claimed invention. The library comprises a plurality of storage areas for housing plurality of hard disk drive device (HDD, see Figures 1A and 4). The library comprises robotic grippers 62 for gripping and moving said HDD 's (Figures 2 and 3) from/to said storage areas. The library comprises a host device 72 (Figure 2) for controlling the library operations. The library comprises plurality of interfaces for communicatively linking the HDD 's to the host device (Figures 2, 3, and 4). Kulakowski '455 data storage library is also capable of handling tape cartridges or a combination of tape and hard disk drive devices

(column 11, lines 21-47). However, Kulakowski '455 is silent as to the specific of the HDD having form factor in the shape of a tape cartridge.

Stefansky '412 discloses a portable hard disk drive device. Stefansky '412 teaches that the hard disk drive device housing can have the dimension of a tape cartridge (column 1, lines 55-61).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have the housing dimension of Kulakowski '455 HDD coincides with the housing dimension of a magnetic tape cartridge, as taught by Stefansky '412, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F .2d 272, 205 USPQ 215 (CCPA 1980). Furthermore, it would have been obvious for one of ordinary skill in the art to have provided Kulakowski '455 HDD with a housing having the same dimension of a magnetic tape housing because such HDD cover had been known in the art, as demonstrated by Stefansky '412.

Since Stefansky '412 modified apparatus and docking device is designed to handle storage media having tape cartridge form factor, it is obvious that the apparatus and the docking device is also capable of handling any tape cartridges. Note that since the housings of the cartridges have the same size and the same tape cartridge form factor, any device housed within the cartridges would have to be able to receive by the docking device. It is obvious that the docking device is adapted to receive any type of storage media, including a magnetic tape, which is housed within the tape cartridge form factor.

In regards to claim 37, Kulakowski '455 discloses all elements per claimed invention as explained above. However it is silent as to the specifics of the HDD having form factor in the shape of a Digital Linear Tape (DLT).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have the housing dimension of Kulakowski '455 HDD coincides with the housing dimension of a Digital Linear tape cartridge since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F .2d 272, 205 USPQ 215 (CCPA 1980).

Claims 45 and 46, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski et al. 6,731,455 in view of Stefansky 5,329,412 as applied to claim 28 above, and further in view of Kim 5,666,342.

Stefansky '412 modified apparatus discloses all elements per claimed invention including the capability of handling any type of storage media that have the same tape form factor housing. However, Stefansky '412 is silent as to the specifics of communicatively linking or reading the tape and HDD storage media to the host device by a single docking interface.

Kim '342 teaches that the integration of different type of docking interfaces provides convenience of use (column 1, lines 32-35). Kim '342 shows that it is possible to integrate a tape-docking interface with a disc-docking interface to form a single docking module.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have provided to Stefansky '412 docking device with an

integrated feature that would allow said docking device to read both tape and HDD media because it provides convenience of use for the apparatus, as taught by Kim '342.

7. Response to arguments:

(B) 35 USC 112 First Paragraph:

Appellant argued that the specification and drawings fully described the claimed invention of how a single docking device can link both a tape cartridge and a hard disk drive to the host device. Appellant referred to the written description, page 1, lines 11-27, and line 16 through page 19, line 18, and figures 1-4 for support. This argument is not persuasive. The entire written description and figures 1-4, at best, only describe how each tape docking device and hard disk drive docking device works. The original disclosure did not provide any enabling evidence for the combination of the docking device being able to actually read/link both the tape and the hard disk to the host. There is no structure description to allow one of ordinary skill in the art to ascertain the physical make up of the integrated docking device. Without such description, one would not be able to make and use the invention without excessive undue experimentation. The mere statement that the device works does not provide sufficient enablement. As a matter of fact, figures 1-4 actually show that the claimed docking device, which is represented in figure 4, is non-enabling. Figures 1 and 2 show how the hard disk drive is docketed to interface 122. Notice the air gap between the hard disk drive's right side and docking device 130. Figure 3 shows tape cartridge 240 and tape drive 230. Notice there is no protruding interface between the elements. In order for the tape drive 230 to access and read tape cartridge 240, the cartridge 240 would have to be flushed against

the tape drive 230. Figure 4 shows the claimed docking device 330 that have the functionality of reading both tape cartridge and hard disk drive. Note that interface 122 will certainly prevents tape 240 from being flushed against docking device 330. Interface 122 creates interference between the tape cartridge 240 and the tape reader 231. The tape reader 231 will not be able to link and read the tape cartridge 240.

(C) claims 28, 37, 38, and 44 35 USC 103 rejection over Kulakowski (6,731,455) in view of Stefansky (5,329,412):

Appellant argued that both references failed to provide the claimed invention because both references do not have a tape cartridge form factor. Appellant argued that Kulakowski does not discloses a tape cartridge and does not disclose a docking device that is "adapted to receive" both a hard disk cartridge and a tape cartridge. These arguments are not persuasive. According to the rejection above, the combination of Kulakowski and Stefansky does disclose a docking device that is adapted to receive both a hard disk cartridge and a tape cartridge. Note that since the housings of the cartridges have the same size and the same tape cartridge form factor, any device housed within the cartridge would have to be able to receive by the docking device. It is obvious that the docking device is adapted to receive any type of storage media, including a magnetic tape, which is housed within the tape cartridge form factor.

(D) claims 45 and 46 35 USC 103 rejection over Kulakowski in view of Stefansky and further in view of Kim (5,666,342):

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reasons to combine the references have been clearly stated in the rejection above.

In response to appellant's argument that the structural combination of the references would render the device non-operable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The motivations and teachings for combining the references have been clearly pointed out in the appropriate rejections above.

8. The copy of the appealed claims contained in the Appendix to the brief is correct.

9. The evidence Appendix (no evidence) is correct.

10. The related proceeding Appendix (no evidence) is correct

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
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KHT
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